

REMARKS

Claims remaining in the present patent application are Claims 1-8. The Applicants respectfully request reconsideration of the above captioned patent application in view of the remarks presented herein.

Applicants note that the "Detailed Action" portion of the rejection fails to reject Claims 2-8, other than under 35 USC § 112, second paragraph. Only Claim 1 is rejected over cited art.

Applicants assume that Claims 2-8 would be allowable if the 35 USC § 112, second paragraph, rejection is overcome.

Finality

The rejection states that Applicant's amendment necessitated the new grounds of rejection, and thus the current rejection is made final. Applicants traverse. The amendments made were of a clarifying nature, e.g., changing "control" to "for controlling said switch" and numbering inputs, substantially in response to Examiner's request. No additional structural elements or restrictions or any other changes to the metes and bounds of the recited claims were introduced as a result of the amendments.

Applicants respectfully assert that a rejection should not be made final for “any” amendment. For example, MPEP § 706.07 cautions, “[b]efore final rejection is in order a clear issue should be developed between the examiner and applicant” and “present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application.”

Applicants respectfully request withdrawal of the finality of the present action because the amendments made by the Applicants did not alter the scope of the claims such that a new search would be warranted.

35 USC § 112

Claims 1-8 are rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants traverse.

The rejection does not appreciate a distinction between terminals “for controlling” a switch, and terminals that are switched, e.g., responsive to such control inputs.

The following example is offered to illustrate to the Examiner some fundamental concepts of the art. In an ordinary electric light wall switch, there are two terminals. One fixed, or unswitched, terminal is coupled to the light socket. The other terminal, a switched terminal, is coupled to the hot wire. A control input, e.g., a manually operated lever, functions to control whether the two terminals are coupled or not coupled, e.g., whether the switch is closed or open. Neither terminal is coupled to the control input, as such coupling would be a safety hazard, in this example.

Similarly, electronic switches may have fixed terminals, terminals that are switched, e.g., “switched terminals,” and control inputs for controlling the function of the switch. For example, a 2:1 multiplexer, or “mux,” generally has one fixed terminal, two switched terminals and one control input. Such terminals and control inputs, described by their function(s), are well understood to be distinct, unless specifically described as having multiple functions.

Claim 1 recites two control inputs, two switched terminals and another terminal. By the language of the claim, their structure and function are clearly

elucidated. Thus, Claim 1 particularly points out and distinctly claims the subject matter which Applicant regards as the invention.

The rejection seems to find significance that “only one connection exists between the substrate and said switch.” The rejection’s purpose in making this statement is unclear to Applicants. Applicants are further confused by this statement, as Claim 1 only recites one terminal coupled to a substrate.

35 U.S.C. § 103

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Lai et al. (US 6,791,146, “Lai”) and further in view of Mergens et al. (US 6,803,633, “Mergens”). Applicants have carefully reviewed the cited references and respectfully assert that embodiments of the present invention as recited in Claim 1 are patentable over Lai in view of Mergens.

With respect to Claim 1, Applicants respectfully assert that Lai in view of Mergens fails to teach or suggest the claimed limitation “a first input for controlling said switch coupled to a first N-well bias supply line” as recited by Claim 1.

The rejection alleges that Lai teaches “a first input 372 coupled to an n-well....” Assuming, *arguendo*, that such allegation is correct, the statement fails to allege teaching of the entire recited element. While the rejection alleges coupling to an n-well, the rejection fails to allege coupling to an “n-well bias supply line,” as recited by Claim 1.

As the rejection fails to even allege teaching of the entirety of this limitation, the rejection fails to establish *prima facie* obviousness.

As the rejection fails to establish *prima facie* obviousness, Applicants respectfully assert that Claim 1 overcomes the rejections of record, and respectfully solicit allowance of this Claim.

In addition with respect to Claim 1, Applicants respectfully assert that Lai in view of Mergens fails to teach or suggest the claimed limitation “a second input for controlling said switch coupled to a substrate bias supply line” as recited by Claim 1.

The rejection alleges that Lai teaches “a second input coupled to a substrate bias supply line 374.” Applicants traverse. In contrast, Lai teaches “terminal 374 of the switch 370 is electrically coupled to the controlled N guard ring 326” (column 5 lines 9-10). Applicants respectfully assert that the taught

“controlled N guard ring 326” is not equivalent to the recited “substrate bias supply line” as recited by Claim 1. Moreover, since 374 is coupled to N material, it is electrically and physically isolated from the P substrate, and hence cannot be the recited “substrate bias supply line” as recited by Claim 1. Applicants respectfully assert that Mergens fails to correct this deficiency of Lai, and respectfully note that the rejection does not allege such correction.

For this additional reason, Applicants respectfully assert that Claim 1 overcomes the rejections of record, and respectfully solicit allowance of this Claim.

Further with respect to Claim 1, Applicants respectfully assert that Lai in view of Mergens fails to teach or suggest the claimed limitation “an output terminal of said switch coupled to a P-type substrate” as recited by Claim 1. The rejection equates the recited switch with switch 370 of Lai, and alleges that Lai terminal 372 is coupled to a p-type substrate. Applicants traverse.

As taught in Lai, terminal 372 is coupled to region 318 and region 320. Regions 318 and 320 sit in n-well 312, and are thus physically and electrically isolated from substrate 300. The other switched terminal of switch 370, terminal 374, is coupled to region 326, which sits in the same n-well 312 and is similarly physically and electrically isolated from substrate 300. Thus, neither

switched terminal of switch 370 teaches or suggests the claimed limitation “an output terminal of said switch coupled to a P-type substrate” as recited by Claim 1. Applicants respectfully assert that Mergens fails to correct this deficiency of Lai, and respectfully note that the rejection does not allege such correction.

For this further reason, Applicants respectfully assert that Claim 1 overcomes the rejections of record, and respectfully solicit allowance of this Claim.

Still further with respect to Claim 1, Applicants respectfully assert that Lai in view of Mergens fails to teach or suggest the claimed limitation “a first switched terminal of said switch coupled to a ground” as recited by Claim 1.

The rejection alleges that Lai teaches “a first switched terminal coupled to control circuit 380.” Herein, the rejection appears to cite to the unlabeled signal line between control circuit 380 and switch 370, e.g., in Figure 3. The rejection then proposes to modify Lai by coupling this signal to ground. Applicants respectfully assert that such modification would render Lai incapable of performing Lai’s intended function, as the switch 370 would be fixed in one mode, e.g., open, and be unable to change or switch to the other

mode, e.g., closed. For example, Lai Figure 4 shows this line is connected to the gate of a FET.

Per *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959), “if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”

As the proposed modification of Lai in view of Mergens renders Lai inoperative, the proposed combination fails to establish *prima facie* obviousness, Applicants respectfully assert that Claim 1 overcomes the rejections of record for this still further reason, and respectfully solicit allowance of this Claim.

Further yet still with respect to Claim 1, Applicants respectfully assert that Lai in view of Mergens fails to teach or suggest the claimed limitation of “a substrate bias supply line” as recited by Claim 1. Applicants respectfully assert that Lai in view of Mergens are silent as to any voltage, bias or otherwise, coupled to a substrate.

For this further yet still reason, Applicants respectfully assert that Claim 1 overcomes the rejections of record, and respectfully solicit allowance of this Claim.

CONCLUSION


Claims remaining in the present patent application are Claims 1-8. The Applicants respectfully request reconsideration of the above captioned patent application in view of the remarks presented herein.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

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